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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,774	02/12/2004	Philip Ted Kortum	1030-LB1039	2947
60533	7590	02/05/2008		
TOLER LAW GROUP 8500 BLUFFSTONE COVE SUITE A201 AUSTIN, TX 78759			EXAMINER AJIBADE AKONAI, OLUMIDE	
			ART UNIT 2617	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/777,774	Applicant(s) KORTUM ET AL.	
	Examiner Olumide T. Ajibade-Akonai	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/17/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-3, 5, 6, 9-11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Granberg 6,195,543** in view of **Matz et al 7,054,642 (hereinafter Matz)**.

Regarding **claim 1**, Granberg discloses a method comprising determining a first real-time, cost-per-unit-time billing rate for an in-progress telephone call of a wireless telephone (calculating call charges, see abstract, figs. 1 and 3, col. 5, lines 56-67, col. 6, lines 1-13); receiving, at the wireless telephone, the first real-time, cost-per-unit-time billing rate (see col. 5, lines 56-67, col. 6, lines 1-12); displaying the first real-time, cost-per-unit-time billing rate on a display of the wireless telephone during the in-progress telephone call (displaying call charges during the call, see abstract, col. 6, lines 1-13).

Granberg does not specifically disclose generating, at the wireless telephone, an audible tone signaling that a rate change event has occurred.

In the same field of endeavor, Matz discloses generating, at the wireless telephone, an audible tone signaling that a rate change event has occurred (generating at a handset a notification of an increase or decrease in calling rates, the notification received by the handset coming in the form of a tone, see col. 5, lines 36-45, col. 14, lines 43-62, and col. 15, lines 15-24).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Matz, by having the handset generate a tone in response to receiving a notification of an increase or decrease in calling rate, into the system of Granberg for the benefit of notifying the handset user of cheap call rates.

Regarding **claim 2**, as applied to claim 1, Granberg further discloses after said displaying the first real-time, cost-per-unit time billing rate: determining a second real-time, cost-per-unit-time billing rate for the in-progress telephone call of the wireless telephone (calculating a charge for a call due to changing conditions, see col. 6, lines 3-10); and displaying the second real-time, cost-per-unit-time billing rate on the display of the wireless telephone during the in-progress telephone call (displaying call charges during the cal, see abstract, col. 6, lines 1-13).

Regarding **claims 3 and 11**, as applied to claims 2, 9, and 10, Granberg further discloses wherein the second real-time, cost-per-unit-time billing rate differs from the first, cost-per-unit-time billing rate (see col. 6, lines 3-7).

Regarding **claims 5 and 13**, as applied to claims 1 and 9, Granberg further discloses determining a first rate description associated with the first real-time, cost-per-unit-time billing rate; and displaying the first rate description on the display of the wireless telephone during the in-progress telephone call (calculating a charge for a call due to changing conditions, and displaying call charges during the call, see abstract, col. 5, lines 66-67 and col. 6, lines 1-13).

Regarding **claims 6 and 14**, as applied to claims 1, 5, 9 and 13 Granberg further discloses wherein the first rate description and the first real-time, cost-per-unit-time billing rate are simultaneously displayed by the display of the wireless telephone (displaying call charges during the cal, see abstract, col. 6, lines 1-13).

Regarding **claim 9**, Granberg discloses a wireless telephone (mobile station 18, see fig. 2, col. 5, line 27-28) comprising: a receiver (radio circuitry 28, see col. 5, lines

27-30) to receive a first real-time cost-per-unit-time billing rate (see col. 5, lines 56-67, col. 6, lines 1-12); and a display (display 30, see fig. 2, col. 5, lines 27-30) to display, during an in-progress telephone call, a first real-time, cost-per-unit-time billing rate for the in-progress telephone call (displaying call charges during the call, see abstract, col. 6, lines 1-13).

Granberg does not specifically disclose a generator for generating, at the wireless telephone, an audible tone signaling that a rate change event has occurred.

In the same field of endeavor, Matz discloses a generator for generating, at the wireless telephone, an audible tone signaling that a rate change event has occurred (generating at a handset a notification of an increase or decrease in calling rates, the notification received by the handset coming in the form of a tone, indicating presence of a tone generator at the handset, see col. 5, lines 36-45, col. 14, lines 43-62, and col. 15, lines 15-24).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Matz, by having the handset generate a tone in response to receiving a notification of an increase or decrease in calling rate, into the system of Granberg for the benefit of notifying the handset user of cheap call rates.

Regarding **claim 10**, as applied to claim 9, Granberg further discloses wherein the display is to display, after displaying the first real-time, cost-per-unit time billing rate but during the in-progress telephone call, a second real-time, cost-per-unit-time billing rate for the in-progress telephone call (calculating a charge for a call due to changing

conditions, and displaying call charges during the call, see abstract, col. 5, lines 66-67 and col. 6, lines 1-13).

3. Claims 4, 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Granberg 6,195,543** in view of **Matz et al 7,054,642 (hereinafter Matz)** as applied to claims 1 and 9 above, and further in view of **Benco et al 7,068,997**.

Regarding **claims 4 and 12**, as applied to claims 1 and 9, Granberg, as modified by Matz discloses the claimed invention. Granberg, as modified by Matz however, does not explicitly disclose wherein the first real-time, cost-per-unit-time billing rate comprises a cost-per-minute rate.

In a similar field of endeavor, Benco et al discloses, wherein the first real-time, cost-per-unit-time billing rate comprises a cost-per-minute rate (see col. 3, lines 55-57).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Benco et al, by calculating the billing rate as a per-minute rate, into the system of Granberg, as modified by Matz for the benefit of providing roaming charge rates to a mobile phone.

Regarding **claim 7**, as applied to claim 1, Granberg, as modified by Matz discloses the claimed invention except wherein determining the first real-time cost-per-unit-time billing rate comprises: sending data indicating the first real-time, cost-per-unit-time billing rate from the remote node to the wireless telephone during the in-progress telephone call.

In a similar field of endeavor, Benco et al discloses wherein determining the first real-time cost-per-unit-time billing rate comprises: sending data indicating the first real-time, cost-per-unit-time billing rate (per-minute roaming charge, see figs. 1 and 2, col. 3, lines 20-25, lines 47-51) from the remote node (MSC 26, see col. 3, lines 24-26) to the wireless telephone during the in-progress telephone call (steps 54-64, see fig. 2, col. 3, lines 15-33, lines 48-67, col. 4, lines 1-3).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Benco et al, by calculating the billing rate as a per-minute rate, into the system of Granberg, as modified by Matz for the benefit of providing roaming charge rates to a mobile phone.

4. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Granberg 6,195,543** in view of **Matz et al 7,054,642 (hereinafter Matz)** as applied to claims 1 and 9 above, and further in view of **Himelhoch 20050032505**.

Regarding **claims 8 and 16**, as applied to claims 1 and 9, Granberg, as modified by Matz discloses the claimed invention except displaying a number of days remaining in a billing period on the display.

In the same field of endeavor, Himelhoch discloses displaying a number of days remaining in a billing period on the display (see fig. 1, p.3, [0031], [0033]).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made, to combine the teaching of Himelhoch, by having displaying a billing cycle on a screen of a cell phone, into the system of Granberg, as

modified by Matz, for the benefit of providing subscribers with a way of keeping track of unused minutes, and minutes and costs that exceed the monthly plan.

Response to Arguments

5. Applicant's arguments with respect to claims 1-14 and 16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bernhart 7,072,640 discloses a terminal, method and computer program product for producing a user perceptible output upon reaching a predefined threshold.

Offer 6,954,630 discloses a method for location-based billing for mobile communication.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olumide T. Ajibade-Akonai whose telephone number is 571-272-6496. The examiner can normally be reached on M-F, 8.30p-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rafael Perez-Gutierrez can be reached on 571-272-7915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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